

## REMARKS

The Office Action dated September 10, 2004 has been received and reviewed by the applicant. Claims 1-25 are in the application. Claims 1, 4, 11, 12, 17 and 19 have been amended with minor amendments to improve their form. Claims 21-25 are newly submitted. Claims 1, 2, 5-8, 10, 12-16 and 17-20 stand rejected and claims 4, 9, 11 and 16 stand objected to. The indication of allowable subject matter in the application is gratefully acknowledged. However, reconsideration and allowance of all of the claims as amended is requested for the following reasons:

Claim 1 stands rejected under 35 USC 103(a) as being unpatentable over Yamamoto in view of US 5,859,920 to Daly et al. The rejection of Claim 1 is respectfully traversed. Claim 1 is directed to a method of printing an image on a sheet wherein digital image data is provided representing a pictorial image to be printed on the sheet in hard copy form. Also provided is information for cutting the sheet. The digital image data and the information for cutting the sheet are printed so as to embed **invisible** cutting instructions **within** the pictorial image. Yamamoto is directed to an optical (not digital) exposure printer wherein a portion of an image on an image frame of photographic film is printed through an exposure gate onto a photographic paper. The "trimming" referred to in this patent does not involve cutting at all but merely relates to selection of a portion of the image frame **on the film** for projection onto the photographic paper. There is no disclosure of printing of invisible cutting instructions and embedding same within the printed image as is being claimed in Claim 1. Indeed, in Yamamoto the photographic paper 3 is cut at cutters 32 before entering the exposure station. There is thus no need for printing cutting instructions with the photographic paper because the paper is precut before the image is even exposed thereon, see Yamamoto column 4, lines 8-14. It is recognized that the film has information in magnetic form for identifying trimming instructions. However, these trimming instructions should not be confused with cutting instructions because they merely relate to a segment of the film image that is to be exposed onto the photographic paper. In considering Daly et al. it is noted that there is no disclosure therein regarding instructions for cutting and embedding them within the printed image.

Rather, the disclosure of Daly et al. is merely directed to embedding digital data in a pictorial image wherein the data represents an identifier for the image such as a catalog number, a copyright notice, information about the owner of the copyright such as her name and address, a pointer to additional information, a web site address on the Internet, etc. Nothing within this litany of suggestions teaches or renders obvious subject matter of claim 1. It is further submitted that it would not be obvious to combine Yamamoto with Daly et al. because as noted above there is no need in Yamamoto to even embed cutting information within the print because the print is precut before even being exposed to an image.

Claims 2, 3, 5-8 and 10 also stand rejected under 35 USC 103(a) as being unpatentable over the combination of Yamamoto and Daly et al. As noted above Yamamoto is directed to an optical exposure printer and not a digital printer. Furthermore, there is no need in Yamamoto to even embed instructions for cutting the print because the print is precut before an exposure is made. Also as noted above Daly et al. teaches nothing about providing cutting instructions nor embedding of such instructions as invisible information within the print. It is submitted therefore that the combination of Yamamoto and Daly et al. fails to establish a prima facie case of obviousness under 35 USC 103 to render obvious claims 1 -3, 5-8 and 10.

Claims 12, 13 and 17 stand rejected under 35 USC 103 (a) as being unpatentable over Miyazaki et al in view of Daly et al. Miyazaki et al discloses a printing apparatus wherein an image and a template pattern that surrounds the image are combined for digital printing as a composite image. An operator selects a cutting pattern for cutting the composite printed image such as for use in making of labels. By selecting of the cutting pattern the composite printed image information is modified to size suited for the cutting pattern. However, there is no disclosure in this reference of a merging processor for merging the digital image data representing the pictorial image and the digital information for cutting the sheet wherein the digital information for cutting the sheet is encoded so as to be **invisible** in a print of the pictorial image. Furthermore, there is no disclosure in this reference of a step of forming of **invisible** cutting information **within** the pictorial image. The reason for there being no teaching of these features in Miyazaki et al. is that the cutting pattern has been identified by the operator and that information has no need to be placed within the pictorial image because the

information concerning the cutter is stored within the printing apparatus through such selection by the operator and the appropriate cutter is determined using this information along with a barcode located on the cutting device, see in this regard 49C. One of ordinary skill in the art would hardly consider it to be obvious to combine this reference with Daly et al. for the purpose recited by the Examiner because Miyazaki et al. has no need to incorporate **invisible** cutting instructions within the printed image. Importantly, the printer and cutting apparatus of Miyazaki et al. are so integrated that the operator selects the cutting pattern and this selection modifies the image data but does not in any way print **invisible** cutting instructions **within** the printed image. The cutting instructions selected by the operator are merely stored within the printer apparatus and used accordingly to make cuts on the printed sheet. Thus, the combination of Miyazaki et al. with Daly et al. for the purposes noted by the Examiner is not suggested by the prior art itself but appears instead to be a hindsight reconstruction of the prior art by the Examiner. It is submitted therefore that the Examiner has failed to set forth a prima facie case of obviousness of independent Claims 12 and 13.

Claims 14-15 and 18-19 stand rejected under 35 USC 103(a) as being unpatentable over the combination of Miyazaki et al. and Daly et al. as applied to claim 13 and further in view of Yamamoto. The impropriety of combining of Miyazaki et al. and Daly et al. has been noted above. Miyazaki et al. does not have any need for embedding of **invisible** cutting instructions within a printed image because his printer apparatus has the operator selected cutting information stored within the apparatus and not in the print. Daly et al. provides no hint or suggestion with regard to embedding of invisible cutting instructions within the print. This reference merely discloses embedding of information about the print within the printed image. Yamamoto cuts the print before it is even printed. It is respectfully submitted that it would not be obvious to one of ordinary skill in the art to modify these references as suggested by the Examiner. It is submitted therefore that the Examiner has also failed to establish a prima facie rejection of Claims 14-15 and 18-19.

Claim 20 stands rejected under 36 USC 103(a) as being unpatentable over Daly et al. in view of Miyazaki et al. Daly et al. discloses the embedding of information about a print within the printed image. Miyazaki et al. is directed to an integrated printer and cutter apparatus wherein the cutting

instructions are formed and remain with the apparatus but are not embedded as invisible cutting instructions within the printed image nor would there appear to be any need for providing of such instructions in the prints formed by Miyazaki et al. The Examiner cites Miyazaki et al. as disclosing of a sheet including a plurality of printed images. However, the Examiner recognizes that neither reference discloses the embedding of invisible cutting instructions within the printed image on the sheet nor is there any hint in either of these references of the need for such. It is submitted again that the Examiner has used an impermissible hindsight reconstruction of the prior art in order to set forth a rejection of Claim 20. It is further submitted that the Examiner has also failed to establish a prima facie rejection of Claim 20.

Newly submitted claims 21-25 are also submitted to be patentable over the prior art for the reasons provided above. Support for claims 21-25 are found in the specification, for example see the flowchart of Figure 2 and the pertinent description in the specification at page 7.

For the reasons set forth above, it is believed that the application is in condition for allowance prompt notice of which is earnestly solicited. Accordingly, reconsideration and favorable action are respectfully requested. If, contrary to expectations, questions shall remain the Examiner is invited to call the undersigned in order to advance prosecution of the application towards allowance.

Respectfully submitted,



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If the Examiner is unable to reach the Applicant(s) Attorney at the telephone number provided, the Examiner is requested to communicate with Eastman Kodak Company Patent Operations at (585) 477-4656.